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Patent Docket P2730P1C1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Group Art Unit: 1631

Ashkenazi et al. Examiner: Not yet assigned

Serial No.: 09/941,992

Filed: August 28, 2001

For: Secreted and Transmembrane

Polypeptides and Nucleic Acids

Encoding the Same

TRANSMITTAL OF PROPERTY RIGHTS STATEMENT TO DOE AND/OR NASA

UNDER 42 U.S.C. §§ 2182 and 2457

Assistant Commissioner of Patents ATTN: Licensing and Review Washington, D.C. 20231

Sir:

Applicants submit herewith an executed property rights statement to the DOE and/or NASA under 42 U.S.C. §§ 2182 and 2457 for the above captioned patent application. This property rights statement is submitted in anticipation of the Patent Office issuing a requirement for such a statement in the above captioned patent application as such a requirement was issued by the Patent Office in other related patent applications. Applicants note that this property rights statement is effective not only for the above captioned patent application, but also for all currently pending continuations of the above captioned patent application as shown in Appendix A which is appended to the fully executed property rights statement submitted herewith.

Also submitted herewith is a declaration by the undersigned patent attorney which serves to set forth the reasons why one of the joint inventors of the above captioned application (and all continuation,

divisional and continuation-in-part applications), Nicholas F. Paoni, has refused to sign the herewith enclosed property rights statement to the DOE and/or NASA under 42 U.S.C. §§ 2182 and 2457.

The Commissioner is authorized to charge any fees which may be required, including extension fees, or credit any overpayment to Deposit Account No. 07-0630.

Respectfully submitted,

GENENTECH, INC.

Bv.

Mark T. Kresnak, Ph.D.

Reg. No. 42,767

Telephone: (650) 225-4461

09157

PATENT TRADEMARK OFFICE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ashkenazi et al.

Serial No.: 09/941,992

Filed: August 28, 2001

Group Art Unit: 1631

Examiner: Not yet assigned

For: Secreted and Transmembrane Polypeptides and Nucleic Acids

Encoding the Same

<u>DECLARATION OF MARK T. KRESNAK REGARDING THE REFUSAL OF INVENTOR NICHOLAS F. PAONI TO SIGN DOCUMENTS UNDER MPEP §§ 151 AND 409.03(d)</u>

Assistant Commissioner of Patents ATTN: Licensing and Review Washington, D.C. 20231

Sir:



- I, MARK T. KRESNAK, hereby declare as follows:
- 1. I am a patent attorney employed by the assignee of the above captioned patent application (and all continuations, divisionals and continuation-in-part applications thereof), Genentech, Inc., 1 DNA Way, South San Francisco, California 94080.
- 2. I have a power of attorney in the above captioned patent application (and all continuations, divisionals and continuation-in-part applications thereof) and am authorized to sign documents related to the prosecution of these patent applications on behalf of the assignee, Genentech, Inc.
- 3. In response to U.S. Patent Office notices requiring the submission by Applicants of a Property Rights Statement to the DOE and/or NASA under 42 U.S.C. §§ 2182 and 2457 in the above captioned patent application and/or certain other related patent applications, I prepared such a Property Rights Statement and forwarded copies thereof to each of the inventors of the above captioned patent application (and all continuations, divisionals and continuation-in-part application thereof) for execution.



4. One of the inventors to whom this statement was forwarded is Nicholas F. Paoni. The statement

was sent to Mr. Paoni at his current address which is 51365 Amesburry Way, Granger, Indiana 46530.

Nicholas F. Paoni was named as an inventor in the above captioned patent application (and all

continuations, divisionals and continuation-in-part application thereof) based upon work he performed while

employed by the current assignee, Genentech, Inc. Mr. Paoni's employment with Genentech, Inc. was terminated

on September 19, 2001 and he is no longer employed by Genentech, Inc.

Since Mr. Paoni's employment with Genentech, Inc. was terminated, Mr. Paoni has expressed 6.

to me an unwillingness to sign any documents related to the prosecution of Genentech, Inc. patent application on

which he is a named inventor.

Based upon this unwillingness to sign documents related to Genentech, Inc. patent applications 7.

on which he is a named inventor, Mr. Paoni has refused to execute the Property Rights Statement to the DOE

and/or NASA under 42 U.S.C. §§ 2182 and 2457 referenced above. As such, the Property Rights Statement

to the DOE and/or NASA under 42 U.S.C. §§ 2182 and 2457 submitted herewith is executed by all of the

named joint inventors except for Nicholas F. Paoni.

8. I declare further that all statements made herein of my own knowledge are true and that all

statements made on information and belief are believed to be true and further that these statements are made with

the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both,

under Section 1001 of Title 18 of the United States Code and that all such willful false statements may jeopardize

the validity of the application or any patent issuing thereon.

Date: <u>(0 - 8 - 02</u>

Signed:

Mark T. Kresnak, Ph.D.

Section Patent Counsel

Genentech, Inc.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| In re Application of: | Group Art Unit: 1631 |
|--|----------------------------|
| Ashkenazi et al. | Examiner: Not yet assigned |
| Serial No.: 09/941,992 | |
| Filed: August 28, 2001 | |
| For: Secreted and Transmembrane Polypeptides and Nucleic Acids Encoding the Same | |

PROPERTY RIGHTS STATEMENT TO DOE AND/OR NASA (42 U.S.C. §§ 2182 and 2457) -INVENTORS EMPLOYED BY AN ORGANIZATION

Assistant Commissioner of Patents ATTN: Licensing and Review Washington, D.C. 20231

Sir:

PECEIVED

OCT 1 5 2002

LICERSING & PENTILY We, as joint inventors named in the above captioned patent application and the continuation applications of the above captioned patent application as listed on the herewith attached Appendix A, hereby declare with respect to the invention(s) described and claimed in the above captioned patent application and in the continuation applications of the above captioned patent application as listed on the herewith attached Appendix A that:

- 1. We made and conceived (a) the invention described and claimed in the above captioned U.S. patent application Serial No. 09/941,992 filed in the United States of America on August 28, 2001 and entitled "Secreted and Transmembrane Polypeptides and Nucleic Acids Encoding the Same" and (b) the invention(s) described and claimed in the continuation applications of the above captioned patent application as listed on the herewith attached Appendix A (henceforth the "Inventions");
- 2. We made and conceived these Inventions while employed by Genentech, Inc., 1 DNA Way, South San Francisco, California, 94080;

3. These invention(s) are related to the work we are employed to perform (or were employed

to perform, if no longer employed by Genentech, Inc.) and were made within the scope of our employment

duties; that these inventions were made during working hours and with the use of facilities, equipment,

materials, funds, information and services of Genentech, Inc.;

4. To the best of our knowledge and belief, these Inventions were not made or conceived in

the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered

into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy

Research and Development Administration or the Department of Energy;

5. To the best of our knowledge and belief, these Inventions were not made (conceived or first

actually reduced to practice) under, nor is there any relationship of these Inventions to the performance of

any work under any contract of the National Aeronautics and Space Administration;

6. We declare further that all statements made herein of our own knowledge are true and that

all statements made on information and belief are believed to be true and further that these statements are

made with the knowledge that willful false statements and the like so made are punishable by fine or

imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that all such willful

false statements may jeopardize the validity of the application or any patent issuing thereon.

Full name of first inventor

| Avi Ashkenazi 1456 Tarrytown Street, San Mateo, CA 94402 Citizenship: US Inventor's signature: AT Ashkenam | Date: 9/5/02 |
|---|--------------|
| Full name of second joint inventor | |
| Kevin P. Baker 14006 Indian Run Drive, Darnestown, MD 20878 | |
| Citizenship: GB | Date |
| Inventor's signature: | Date: |

- These invention(s) are related to the work we are employed to perform (or were employed to perform, if no longer employed by Genentech, Inc.) and were made within the scope of our employment duties; that these inventions were made during working hours and with the use of facilities, equipment, materials, funds, information and services of Genentech, Inc.;
- 4. To the best of our knowledge and belief, these Inventions were not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy Research and Development Administration or the Department of Energy;
- 5. To the best of our knowledge and belief, these Inventions were not made (conceived or first actually reduced to practice) under, nor is there any relationship of these Inventions to the performance of any work under any contract of the National Aeronautics and Space Administration;
- 6. We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that all such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Full name of first inventor

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Full name of fifteenth joint inventor

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| Citizenship: US | 0,11 |
| Citizenship: US Inventor's signature: Mary Q Naper | Date: <u>Sept 6</u> , <u>A00</u> |
| Full name of sixteenth joint inventor | |
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| Margaret Ann Roy | |
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| Full name of nineteenth joint inventor | |
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Serial No.: 09/941,992
Filed: August 28, 2001
Full name of fifteenth joint inventor

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Full name of fifteenth joint inventor

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Full name of fifteenth joint inventor

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Full name of twenty-first joint inventor

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| Inventor's signature: | Date: |
| Full name of twenty-second joint inventor | |
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| Inventor's signature: | Date: |
| Full name of twenty-third joint inventor | |
| William I. Wood | |
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Serial No.: 09/941,992 Filed: August 28, 2001 Full name of twenty-first joint inventor Colin K. Watanabe 128 Corliss Drive, Moraga, CA 94556 Citizenship: US Inventor's signature: Full name of twenty-second joint inventor P. Mickey Williams 509 Alto Avenue, Half Moon Bay, CA 94019 Citizenship: US Inventor's signature: Full name of twenty-third joint inventor William I. Wood 35 Southdown Court, Hillsborough, CA 94010 Citizenship: US Inventor's signature: _ Date: ___

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| Zemin Zhang | |
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| Citizenship: US | |

APPENDIX A

| Application No | . Application Dat | te File No |
|----------------|-------------------|--------------------------|
| 09/990427 | 14Nov2001 | P2730P1C10 |
| 09/993687 | 14Nov2001 | P2730P1C11 |
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| | 011 | P2730P1C51 |
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| /989721 1 | 9Nov2001 | P2730P1C55 |

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| Application No. | Application Date | File No |
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